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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/601,118
Filing Date: June 23, 2003
Appellant(s): ROBERTSON ET AL.

Mark Nowotarski, Reg. #47,828
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 October 2009 appealing from the Office action mailed 28 April 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Charles F. Haner, A Prediction of Automobile Claims by Psychological Methods, The Journal of Risk and Insurance, vol. 35, no. 1 (Mar. 1968), pp. 49-59

Timo Lajunen and Heikki Summala, Drive Experience, Personality, and Skill and Safety-Motive Dimensions in Drivers' Self-Assessments, Person Individ, Diff. Vol. 19, No. 3 (1995), pp. 307-318

4,975,840

DeTore et al.

12-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

[1] Claims 37-39 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 37 recites step a. "providing to said prospective insured a set of four or more target questions". Subsequently, claim 37 recites a series of method steps directed to the development of the "four or more" target questions, indicating that the four or more questions must "increase the multiple correlation....said increase being statistically significant to at least the 5% level of confidence". Further, as noted, the claim indicates "four or more questions", which is an open ended statement. In other words the claim is drafted to convey an infinite number of questions. Examiner has reviewed the Specification as originally filed and can find reference to only four questions which the "level of confidence" criteria and not a limitless number of questions. Accordingly, Examiner submits that there is insufficient evidence that, at the time the invention was made, Applicant was in possession of a method in which greater than four questions met the 5% level of confidence criteria.

Further, Examiner notes that any survey method, applied with due experimentation, could enable a user to make and use questions producing 5% level of confidence. However, there is insufficient written description of any more than 4 questions of such correlative value being produced by the disclosed method. There is further no evidence that the correlative value of the 4 questions is directly attributable to the claimed method nor would any more than the disclosed 4 questions be evident absent undue experimentation by a practitioner of the method.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[2] Claims 37-39 and 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites "...step g. analyzing said information to select a set of four or more target questions from among said candidate questions such that the survey responses by said sample population.....significantly increase the multiple correlation...".

It is unclear how the questions are selected to ensure the claimed “significant increase”. The claim limitation makes the assumption that the preceding steps will definitively produce 4 or more questions of the claimed correlative value. Examiner submits that merely selecting 50 candidate questions and surveying 200 or more people will not ensure the generation of 4 or more questions of a 5% level of confidence each time the method is practiced. Accordingly, it is not clear how the intended effect of producing 4 or more questions is definitively achieved by the recited method steps. As claimed, the “significant....correlation” statement appears to convey an intended result. There is no indication of how this correlation is determined or why it would automatically occur based on the preceding steps. This limitation appears to convey an expectation rather than providing a positive recitation of methodology for obtaining a high correlation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[3] Claims 37-39 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haner (Charles F. Haner, *A Prediction of Automobile Claims by Psychological Methods*, The Journal of Risk and Insurance, vol. 35, no. 1 (Mar. 1968), pp. 49-59) in view of Lajunen (Timo Lajunen & Heikki Summala, *Drive Experience, Personality, and Skill and Safety-Motive Dimensions in Drivers' Self-Assessments*, Person Individ, Diff. Vol. 19, No.3 (1995), pp. 307-318) and DeTore et al. (United States Patent #4,975,840).

Claims 1-36 have been cancelled.

As per claim 37, Haner discloses a method for risk classification of a prospective insured, said prospective insured applying for automobile insurance, said prospective insured belonging to a demographic group (Haner; page 49, Abstract, paragraphs 1-3 and 7), said method comprising: a. providing to said prospective insured a set of four or more target questions (Haner; page 50, paragraph 4); b. obtaining a set of responses to said set questions from said prospective insured (Haner; page 50, paragraphs 4-5); c. classifying said prospective insured into a risk class based at least in part on said set of responses (Haner; page 49, paragraph 3, page 50, paragraphs 5-7, and page 51, table 1).

Haner further discloses assembly of survey information including f. collecting information from said sample population, said information comprising; i. response to said survey (Haner; page 50, paragraphs 4-8); ii. the number of automobile insurance claims reported by each of said persons in said sample population (Haner; page 51, paragraph 1-3 and Table 1); and iii. conventional classification information for automobile insurance underwriting, said conventional classification information comprising; 1. age ; 2. marital status (Haner; Abstract and page 49, paragraph 1).

As noted above, Haner disclose a personal inventory (i.e., questions/response) directed to the determination of the attitude and personality of the prospective insured (Haner; page 49, paragraphs 5-7 and page 50, paragraphs 1-3), and Haner further discloses well known conventional classification factors including age and marital status (Haner; Abstract and page 49, paragraph 1), Haner fails to disclose the distillation of four or more representative questions from

a broad survey of 200 or more individuals. Haner further fails to disclose derivation of four or more questions derived from 50 or more questions administered in the survey.

However, Lajunen discloses providing a questionnaire, wherein a person gives self-assessed skill estimates and safety motives and are asked to assess their own abilities and personality (Lajunen; page 308, paragraphs 1-2 and 5, page 309, paragraphs 1-2).

Lajunen further discloses a technique wherein said set of four or more questions have been devised by a survey method comprising the steps of: c. providing said survey to a sample population of 200 or more people (Lajunen; page 307, paragraph 2); Lajunen further discloses back ground variables (i.e., conventional factors) including 3. years of driving experience; 4. number of miles driven per year (Lajunen; page 309, paragraph 8 and page 314, paragraph 1-2);

Regarding step d. composing a survey of 50 or more questions that tap into personality traits that may affect accident involvement and reporting; Lajunen discloses multiple surveys and tested personality traits and specifically mentions deriving questions from multiple studies including 13/5 choice items from *The Driver Skill Inventory*, 20 items from Hatakka et al., and 9 additional measures from Naatanen-Summala (Lajunen; page 308, paragraphs 10-11 and page 309, paragraph 1).

As to step g., Lajunen's correlation method reads on step g. analyzing said information to select said set of four or more questions from among said survey questions such that the survey responses by said sample population to said set of four or more questions significantly increase the multiple correlation between said survey responses and automobile insurance claims reported by said sample population when said conventional classification information is controlled for, said increase in the multiple correlation being significant to at least the 5% level (Lajunen; page 309 paragraphs 2-8, page 310 1-4 and Tables 1-4)

NOTE: *Lajunen employs data from self-reported accidents as opposed to insurance claims. Examiner considers self-reported accidents and insurance claims equivalent data sources with respect to the development of questions and responses to questions and driving tendencies. Both provide a source value for a number of accidents. Further of note, Haner discloses correlations made to insurance claims (Haner; page 49, paragraph 3, page 50, paragraphs 5-7, and page 51, table 1).

NOTE: Lajunen describes extensive analysis of the self-assessments directed to determining those motives and traits most contributory to the driving attributes of the surveyed individuals.

At the time the invention was made, it would have been obvious to include the features of Lajunen within the method taught by Haner with the motivation of measuring skill and safety-motive dimensions in drivers self-assessment of the their driving abilities (Lajunen; Summary on page 307) and to properly predict insurance applicant accident susceptibility to accurately determine insurance premiums (Haner; page 49, paragraph 3).

Haner and Lajunen fail to disclose whether the classification is performed "automatically".

However, as is evidenced by DeTore, automatic risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, wherein the classification is performed by an expert module without input from the underwriter (i.e., automatically) (DeTore; col. 5, lines 19-68, col. 10, lines 43-54, col. 14, lines 50 to col. 15, lines 18), is well known in the insurance underwriting art.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of DeTore within the method taught collectively by Haner and Lajunen with the motivation of providing an automated system for assessing risk without the aid or intervention of underwriters, thus improving efficiency, quality, and consistency of decisions (DeTore; col. 6, lines 3-10).

As per claim 38, Lajunen discloses a method wherein said set of four or more questions comprises not more than ten questions (Lajunen; page 308, paragraphs 10-11 and page 309, paragraph 1).

As per claim 39, Lajunen discloses a method wherein said set of four or more questions comprises not more than four questions (Lajunen; page 308, paragraphs 10-11 and page 309, paragraph 1).

NOTE: Regarding currently amended claims 38 and 39, Lajunen provides instances of multiple surveys employing 4-20 survey items (i.e., questions) (see claim 37 analysis). Examiner submits that the specific number of questions constitutes a design choice as evidenced by the different statistical measures provided in the Lajunen disclosure.

Claims 40-43 have been cancelled.

As per claim 44, Haner discloses a method wherein said method further comprises the steps of:

- b. obtaining a set of responses to said second set of questions (Haner; page 50, paragraphs 4-5);
- and c. in said step of classifying said prospective insured into a risk class based at least in part on said set of responses to said four or more questions, also basing said classification of said prospective insured at least in part on said set of responses to said second questions (Haner; page 49, paragraph 3, page 50, paragraphs 5-7, and page 51, table 1).

While Haner discloses known background elements (i.e., second questions) including age and marital status, Haner fails to indicate background elements (i.e., second questions) including mileage and driving experience.

However, Lajunen discloses step a. providing to said prospective insured a second set of questions related to one or more of said prospective insured age, gender, annual mileage or driving experience (Lajunen; page 309, paragraph 8 and page 310, paragraphs 1-2).

Haner and Lajunen fail to disclose whether the classification is performed "automatically".

However, as is evidenced by DeTore, automatic risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, wherein the classification is performed by an expert module without input from the underwriter (i.e., automatically) (DeTore; col. 5, lines 19-68, col. 10, lines 43-54, col. 14, lines 50 to col. 15, lines 18), is well known in the insurance underwriting art.

As per claim 45, Lajunen discloses a method wherein said personality traits comprise: a. impulsivity; b. locus of control; c. self-esteem; d. invulnerability; e. hostility; f. anger; g. trust; h. social desirability; and i. thoroughness in decision making (Lajunen; page 309, paragraphs 2-8 and page 310, paragraphs 1-2, and TABLE 1) NOTE: While Lajunen specifically discloses a number of the personality traits claimed by Applicant, Examiner considers the specific questions and personality traits measure to constitute non-functional data elements as the specific questions or traits measured does not functionally contribute to the determination of relevant personality traits and categorization of individuals into risk classifications).

As per claim 46, Lajunen discloses a method wherein at least one of said survey questions is a personal statement with which a person is asked to indicated agreement or disagreement (Lajunen; page 310, paragraphs 1-2).

Claims 47 in cancelled.

Regarding claims 38-39 and 44-46, the obviousness and motivation to combine as discussed with regard to claim 37 above are applicable to claims 38-39 and 44-46 and are herein incorporated by reference.

(10) Response to Argument

In the Appeal Brief filed 26 October 2009, Appellant makes the following arguments:

- (A) Applicant argues that claims 37-39 and 44-46 meet the requirements under 35 U.S.C. 112, first paragraph, as being directed towards subject matter that the applicant was in possession of when the application was filed.
- (B) Applicant argues that claims 37-39 and 44-46 meet requirements under 35 U.S.C. 112, second paragraph, as particularly pointing out and distinctly claiming the subject matter which applicant regards as the invention.
- (C) Applicant argues that claims 37-39 and 44-46 are patentably distinct in consideration of Haner, in view of Lajunen, and further in view of DeTore et al.

Examiner will address the Appellant's arguments in the order deemed most relevant to addressing the prospective patentability of the presented claims.

Arguments (C):

In response to Appellant's argument (C), Appellant provides secondary commentary including (1) Examiner fails to establish a prime facie case of obviousness and motivation to combine the applied teachings, (2) Examiner "misreads" teachings provided by Lajunen, (3) Examiner ignores Dr. Thompson's declaration.

Examiner initially notes that Appellant's arguments with respect to the art of record as applied to independent claim 37 rely exclusively on commentary provided by Dr. Thompson. Further, Appellant's arguments with respect to independent claim 37 are exclusively directed to perceived shortcomings of one applied reference, Lajunen. Examiner notes, appreciates, and agrees with Dr. Thompson's helpful commentary with respect to the personality traits tested by Lajunen, insights into the "goals" and "interests" of Lajunen, the source of the questions employed by Lajunen, the perceived costs associated with surveying "200 or more" individuals, the difference between driver safety and accident reporting, the examples of studies surveying more than 200 people as provided by Lajunen, the age of the surveyed individuals, reduction of questions to a "critical few", and other commentary provide by Dr. Thompson. However, Dr. Thompson's commentary is absent of any discussion or consideration of the teachings of (secondary reference) Lajunen in view of those provided by Haner and DeTore et al. The absence of such consideration is noteworthy.

Examiner notes for Appellant's benefit that in the rejection under appeal, there is no 102 rejection of the claims as anticipated by Lajunen. Appellant is further reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to the dependent claims, Appellant similarly provides piecemeal arguments noting teachings of Haner and DeTore and further noting an absence of teachings in those references. In each of these instances, the noted features are not relied upon by the Examiner as provided by the noted reference but are rather based on a combination of teachings and the information conveyed to one of ordinary skill in the art. There is no 102 rejection of the submitted claims based on any one of the three applied references.

In summary response, Examiner relies on the following: Haner discloses that it is well known to utilize survey methods to correlate insurance accident claims and psychological profiles of prospective insured by survey methods (*see inventory and classification Haner; pg. 50, 51 and see level of confidence data pgs. 56 and 57). Also see group risk classification influences

premiums, Haner; pg. 50 paragraphs 4-8 and pg. 51. Accordingly, Examiner maintains that Haner discloses a personal inventory (i.e., questions and responses) directed to the determination of the attitude and personality of the prospective insured and further correlating the inventory assessment with insurance claims (*see predicting automobile insurance claims by psychological methods).

Examiner concedes that Haner fails to disclose the specifics of the survey method used in the personal inventory (e.g., number of questions, number of individuals surveyed etc.). However, Examiner directs Appellant's attention to the applied teachings of Lajunen. As noted by Appellant on page 20 of the Appeal Brief, Lajunen presents a number of exemplary studies surveying between 113-1200 individuals. While Appellant attacks one of these studies (Spolander) as not teaching every limitation of the claimed invention, Examiner relies on these teachings as indicative to one of ordinary skill in the art that studies involving 200 more individuals are well known in the art. Examiner further relies on the teachings provided by Lajunen as suggestive to one of ordinary skill in the art that the number of individuals surveyed is a matter of design choice obvious to one of ordinary skill in the art as a function of the limitations of the study. This is further evidenced by Dr. Thompson, who correctly notes that it would be most expensive to survey 200 or more people as opposed to 113.

Examiner further relies on Lajunen to provide a general teaching of determining correlations between questions/responses and predictions of driver accidents (Lajunen; page 309 paragraphs 2-8, page 310 1-4 and Tables 1-4). Examiner maintains that the number of questions and number

of individuals surveyed in determining the correlative value of questions/driver inventories is a matter of design choice. This would be obvious to one of ordinary skill in the art based on the variable studies presented by Lajunen in which driver inventories (i.e., surveys) are correlated with accidents (Lajunen; page 309 paragraphs 2-8, page 310 1-4 and Tables 1-4). Examiner further notes that Lajunen determines the correlative value of various inventories and personality traits (surveys) with respect to determining the predictive value of the inventory in predicting risky driving (Lajunen; page 309 paragraphs 2-8, page 310 1-4 and Tables 1-4). Examiner maintains that it would have been obvious to one of ordinary skill to select the inventories which provide the highest correlation to employ in the insurance determinations of Haner. Examiner concedes that Lajunen employs self-reported accidents in contrast to insurance claims. While Examiner maintains that these both provide source data for accident rates, the use of claims data in making such survey based correlations is well evidenced by Haner.

DeTore is applied to evidence that automatic risk classification performed by a computer for a particular applicant based on data collected including information which may have a bearing on insurability, wherein the classification is performed by an expert module without input from the underwriter (i.e., automatically) (DeTore; col. 5, lines 19-68, col. 10, lines 43-54, col. 14, lines 50 to col. 15, lines 18), is well known in the insurance underwriting art.

Examiner lastly notes that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have sufficient motivation to combine the individual [elements] forming the claimed [invention]." See *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Argument (A):

In response to Appellant's (A), Examiner notes that Applicant provides supportive commentary that (1) the Specification provides examples of additional target questions (2) the Specification describes how to generate additional questions (3) Examiner ignores Dr. Thompson's declaration.

In response, Examiner notes that the above noted rejection is made on the basis of proper written description in contrast to the enablement requirement of 35 U.S.C. 112, first paragraph. In other words, the rejection was made in accordance with the number of questions Applicant was in the possession of at the time the invention was made, not whether the disclosure would enable one or skill to construct additional questions. Examiner notes that any survey method, applied with due

experimentation, could enable a user to make and use questions producing 5% level of confidence. However, there is insufficient written description of any more than 4 questions of such correlative value being produced by the disclosed method. Further, Examiner maintains that there is no evidence that the correlative value of the 4 questions is directly attributable to the claimed method nor would any more than the disclosed 4 questions be evident absent undue experimentation by a practitioner of the method.

Claim 37 recites "four or more target questions...". This statement is open ended thereby indicating an infinite number of questions. Examiner could find no indication that Applicant was in possession of an infinite number of questions at the time the invention was made nor was Applicant in possession of a method which definitively produces such questions.

Examiner further notes the listing of the four disclosed questions on page 4 of the specification beginning with "I don't find it particularly difficult to get along with loud mouthed obnoxious people". Examiner maintains that a correlation, as disclosed by Applicant (5% level of confidence) could be determined by any survey method in which a sufficient number of individuals are posed the questions such that a 5% level of confidence can be determined. In other words, the correlative value of the question is equally likely to be attributable to question itself as it is to the disclosed method. There is insufficient evidence that the attributes of the claimed method were (1) responsible for the generation of the claimed correlation or that (2) the claimed method produced any more than 4 questions of the claimed correlative value.

Argument (B):

In response to Appellant's argument (B), claim 37 recites "...step g. analyzing said information to select a set of four or more target questions from among said candidate questions such that the survey responses by said sample population.....significantly increase the multiple correlation...". It is unclear how the questions are selected to ensure the claimed "significant increase". The claim limitation makes the assumption that the preceding steps will definitively produce 4 or more questions of the claimed correlative value. Examiner submits that merely selecting 50 candidate questions and surveying 200 or more people will not ensure the generation of 4 or more questions of a 5% level of confidence each time the method is practiced. Accordingly, it is not clear how the intended effect of producing 4 or more questions is definitively achieved by the recited method steps. As claimed, the "significant....correlation" statement appears to convey an intended result. There is no indication of how this correlation is determined or why it would automatically occur based on the preceding steps. This limitation appears to convey an expectation rather than providing a positive recitation of methodology for obtaining a high correlation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R. David Rines/

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Conferees:

/Beth V. Boswell/

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